

REMARKS

Claims 1, 2, 4, 26 and 83-85 were pending in this application.

I. Claim Rejection Under 35 U.S.C. § 112, second paragraph

Claim 85 has been rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Applicants respectfully traverse the rejection and its supporting remarks. While the NMB number readily identifies the corresponding NCBI entry, Appendix B includes two numbers for each NMB number (e.g., “NMB0001 acetyltransferase, putative **491 3**” (emphasis added)). These two numbers indicate the start nucleotide and the end nucleotide of the ORF for the referenced NMB number in SEQ ID NO: 1. While the gene sequence in the NCBI may change (though it is carefully curated and any changes are documented, so one of skill in the art could readily obtain the sequence in its form as of the effective date), SEQ ID NO: 1 is part of the specification and therefore won’t change. Thus, one of skill in the art can readily determine the metes and bounds of the claim.

Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 85 under 35 U.S.C. 112, second paragraph.

II. Claim Rejections Under 35 U.S.C. § 103 – Kraus

Claims 1-2, 4, 26, and 83-85 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Kraus *et al.* (US 5,183,884).

Applicants respectfully traverse the rejection and its supporting remarks. The Examiner has cited to MPEP 2106(VI) for the assertion that SEQ ID NO: 1 is merely non-functional descriptive material. However, this is the same assertion that the Examiner made in the 35 U.S.C. 103(a) rejection over Ribot *et al.* in the Office Action dated January 22, 2009. (*See*, page 7). The

Examiner indicated in that Office Action that “a possible solution to overcoming this rejection is to incorporate withdrawn claim 3 into instant claim 1 wherein the physical expression of proteins from the actual sequence (i.e., not just an *in silico* representation of SEQ ID NO 1) is required.” *See*, page 9. In the response dated July 2, 2009, Applicants opted for this solution and amended claim 1 to incorporate the limitations of claim 3. In the next Office Action dated November 12, 2009, the Examiner did not reiterate the citation to MPEP 2106(VI), acknowledging that SEQ ID NO: 1 has a functional impact on the practice of the claims. The Examiner appeared to have only maintained the rejection based upon an interpretation of the claims which would read upon fragments of SEQ ID NO: 1 rather than the entire SEQ ID NO: 1. Applicants amended claim 1 to address this interpretation. However, the Examiner has now returned to the assertion that SEQ ID NO: 1 is non-functional despite having previously indicated that the final step of “producing a protein comprising the identified amino acid sequence” would make SEQ ID NO: 1 functional. Applicants agree with the Examiner’s original position that SEQ ID NO: 1 is clearly functional in the currently pending claim 1 given that the method can be used to express over 2000 different and unique proteins (*see*, Appendix B). By contrast, Kraus *et al.* only teaches expression of a single protein that is not even a *Neisserial* gene. Therefore, Kraus *et al.* do not teach expression of even one of the over 2000 different and unique proteins that could be expressed practicing the claimed methods.

Applicants therefore respectfully request that the Examiner withdraw the rejection of claims 1-2, 4, 26, and 83-85 under 35 U.S.C. 103(a).

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **529552001600**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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